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| 10/825,836 | 04/17/2004 | Wade C. Horton | HORTON-PA-1 | 8772 |
| <div>7590 07/07/2010</div> <div>OBER / KALER c/o Royal W. Craig 120 East Baltimore Street Baltimore, MD 21202</div> | | | | |
| EXAMINER | | | | |
| FIGUEROA, ADRIANA | | | | |
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| 3633 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,836

Applicant(s)

HORTON, WADE C.

Examiner

ADRIANA FIGUEROA

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations: "the thin rigid sheet of material having an annular lip protruding rearwardly there from for insertion into, seating within and proper positioning with said cutout" recited in claim 1 and "the accent frame flares slightly away from the planar surface" recited in claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 7 is objected to because of the following informalities: claim 7 appears with a wrong status since this claim was cancelled in the response filed on 04/25/2009. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 8, the limitations "wherein said article is an electrical box with a screw mounted outlet or switch plate and wherein said frame is secured in place between the structure and the outlet or switch plate" present a conflict with the limitation in claim 1 of "a recessed lighting fixture" since the switch plate can not be a recessed lighting fixture

at the same time. Thus, the embodiment claimed in claim 8 was not disclosed in the original disclosure and is therefore not enabled.

Examiner would like to note that claim 8 was originally restricted and withdrawn by applicant, however, the restriction requirement was withdrawn in the previous Office Action, accordingly, claims 1-4, 6, 8-11, 13 and 14 were examined.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 8-11, 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape" in lines 8-9 and "the flat two-dimensional object-shaped outer edge" in line 15. Examiner contends that "the object-shaped outer edge" has three dimensions, length, width and thickness. Only images would truly be two dimensional. Even a sheet of paper has some thickness and is three dimensional.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6, 9, 10, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239).

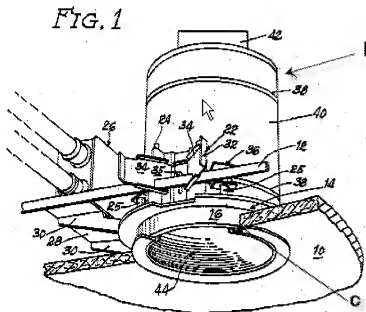
Regarding claim 1, as best understood, Bobrick discloses in combination with a ceiling (10) comprising a planar surface defined by opposing sides and having a circular cutout (c) there through, a recessed lighting fixture (l) mounted on one side of said planar surface over said cutout and conforming thereto, (annotated Fig 1), and a finishing ring (46) defined by an aperture conforming to said cutout, said finishing ring being mounted on another side of said planar surface around said cutout and attached to the recessed lighting fixture (l) for providing a transition from said planar surface to said recessed lighting fixture, (Fig 1, Fig 5), but does not disclose an accent frame comprising a rigid thin sheet of material said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape larger in diameter than a finishing ring, and a circular inner edge defining an aperture conforming to said cutout, and having an annular lip circumscribing said aperture and protruding rearwardly there from for insertion into, seating within, and proper positioning with said cutout, said accent frame being sandwiched between said finishing ring and planar surface and maintained in place there between by the pressure of said finishing ring being retained to said recessed lighting fixture; the flat two-dimensional object-shaped outer edge of said accent frame protruding beyond said finishing ring and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface.

However, Hill teaches an accent frame(10) comprising a rigid thin sheet of material said rigid thin sheet having an outer edge (e) defining "as best understood" a flat two-dimensional object-shape larger in diameter than a finishing ring (5), and an inner edge (c) defining an aperture conforming to a cutout, and having an annular lip (l) circumscribing said aperture; said accent frame (10) being sandwiched between said finishing ring (5) and a planar surface and maintained in place there between by the pressure of said finishing ring being retained to the switch plate, (Fig 4); the flat two-dimensional object-shaped outer edge (e) of said accent frame (10) protruding beyond said finishing ring (5) and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface, (Fig 1, 2, 4). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the lighting fixture assembly of Bobrick to include an accent frame as taught by Hill in order to provide an ornamental appearance and to enhance the general appearance of the lighting fixture assembly.

It would have been an obvious matter of design choice to modify the rigid thin sheet of material to have the inner edge defining a circular aperture, since such a modification would have involved a mere change in the shape of the component and would provide accent frames that can be used in the circular cutout of Bobrick. A change in shape is generally recognized as being within the level of ordinary skill in the art. Further, one would not try to place a rectangular accent frame into the round

opening of Bobrick. Those of ordinary skill in the art know that round pegs go in round holes.

The annular protruding lip of Hill does not protrude rearwardly there from for insertion, seating within, and proper positioning with said cutout. However Bobrick teaches that it is well known in the art to have a protruding lip (48) that would allow for easier insertion of the element (46) into the cutout (Fig 2, 5). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the rigid thin sheet of material of Hill to include a protruding lip as taught by Bobrick in order to allow for easier insertion of the element into the cutout. Further, the examiner contends that it is known to those of ordinary skill in the art that the protruding lip would help to center the accent frame in place and prevent it from becoming off centered behind the finishing ring.



Regarding claim 2, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) having a decorative outer edge (e), (annotated Fig 1, 2).

Regarding claim 3, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) being seated flush with said planar surface (p), (annotated Fig 4).

Regarding claim 6, Bobrick modified by Hill discloses as discussed above, but does not specifically teach that said thin sheet of material is approximately 1 mm thick. However, it would have been a matter of design choice to make the thin sheet approximately 1 mm thick, since such a modification would have involved a mere change in the size of the component and would provide a light weight sheet. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 9, Bobrick modified by Hill discloses as discussed in claim 1 Bobrick further teaches the planar surface being a ceiling (10), (Fig 1).

Regarding claim 10, Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose said accent frame is constructed of a rigid material selected from the group consisting of wood, metal or plastic materials. However, it would have been a matter of design choice to construct the frame of wood, metal or plastic materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Further, all of the above materials would be obvious to use because they are all known to be easily shaped into a desired configuration.

Regarding claim 13, Bobrick modified by Hill discloses the basic claimed invention as discussed above. Hill further teaches the accent frame (10) is both decorative and is capable of covering up any imperfections in the edges of the cutout not covered by the finishing ring.

Regarding claim 14, Bobrick modified by Hill discloses the basic claimed invention as discussed in claim 1, but does not disclose the object-shape is a closed form selected from the group consisting of a star, flower or a house. However, it would have been an obvious matter of design choice to modify the object of Bobrick and Hill to have a shape of a star, flower or a house, since such a modification would have involved a mere change in the shape of the component and would provide different decorative motives. A change in shape is generally recognized as being within the level

of ordinary skill in the art. *In re Dailey*, 357 *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Further, the examiner contends that the shape of the device does not constitute a patentable feature. The shape of the device is purely for decorative purposes.

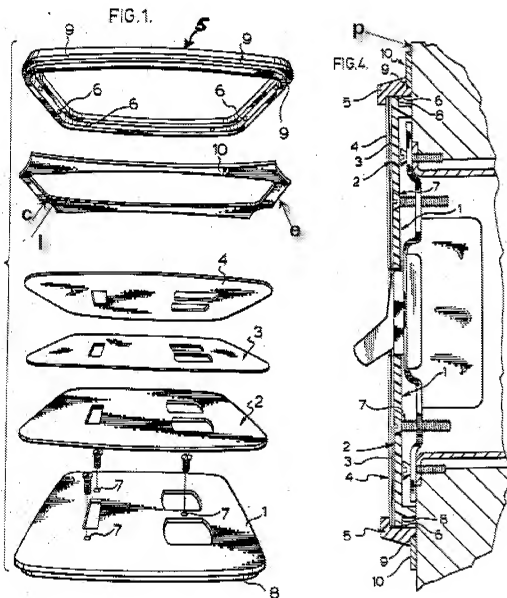
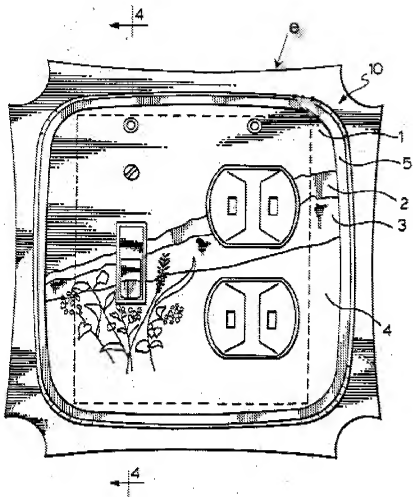


FIG. 2.



6. Claim 4, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239) and further in view of Baldwin (US 6,281,440). Bobrick modified by Hill discloses the basic claimed invention as discussed above, but does not disclose that the accent frame flares slightly away from the planar surface to provide an aesthetically pleasing depth or texture to the frame. However, Baldwin teaches an accent frame (11) that flares slightly away from the planar surface (23). (Fig 1, 3). Therefore, it would have been obvious to a person having

ordinary skill in the arts at the time of the applicant's invention to modify the accent frame of Bobrick and Hill to flare slightly away from the planar surface as taught by Baldwin in order to enhance the ornamental appearance of the frame.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239) and further in view of Gretz (US 6,152,413). Bobrick modified by Hill discloses the basic claimed invention as discussed in claim 1, but does not disclose said accent frame is formed by injection molding. However, Gretz discloses a frame (10) formed by injection molding (Column 4, Lines 56-60). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the frame of Bobrick and Hill to be formed by injection molding as taught by Gretz in order to provide a stronger and flexible frame. The examiner would also like to point out that the injection molding limitation is a process limitation. Therefore, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Thus, even though Bobrick in view of Hill disclose the claimed invention, Gretz was further used to show that it is known to injection mold a frame.

Response to Arguments

8. Applicant's arguments filed 4/9/2010 have been fully considered but they are not persuasive.

9. In response to applicant's argument regarding the drawings objections, examiner asserts that under 37 CFR 1.83(a), the drawings must show every feature of the invention specified in the claims. Figures 1 and 2 do not show the claimed limitations of "a lip extending rearwardly", or "the accent frame flares slightly away from the planar surface". Figures 1 and 2 only show a plain view and a perspective view of the accent frame, there is not a cross section that would show the claimed limitations. Thus the drawings objection is maintained.

10. In response to applicant's argument regarding the 112th second rejection of claim 1. Examiner asserts, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "'flat two dimensional object-shape" in claim 1 is used by the claim to mean "no perceptible thickness", while the accepted meaning is "having two dimensions." The term is indefinite because the specification does not clearly redefine the term. The specification states "a thickness of approximately 1 mm". Examiner contends that "the rigid thin sheet" has three dimensions, length, width and a thickness that even if is sufficiently thin is a thickness.

Only images would truly be two dimensional. Even a sheet of paper has some thickness and is three dimensional. Thus the 112th second rejection is maintained.

11. In response to applicant's argument that "Bobrick does not teach an annular lip that is advantageous for allowing easier insertion of the element (46) into the cutout". Examiner would like to point out that during examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification, MPEP 2111.01 [R-5]. The term "lip" is interpreted as a projecting edge that is capable of allowing easier insertion of the element (46) into the cutout.

12. In response to applicant's argument that "the accent frame of Hill is not capable of covering structural irregularities that may exist around the cutout". Examiner would like to point out that during examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification, MPEP 2111.01 [R-5]. The term "imperfections" is interpreted as any defect or flaw in the surface around the cutout. Examiner contends that the accent frame of Hill would cover any irregularities and imperfections around the edges of the cutout either structural or cosmetic.

13. In response to applicant's argument that "it would not be obvious to modify the accent frame of Bobrick and Hill to have a shape consisting of a star, flower or house". Examiner would like to note that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed

invention from the prior art. Examiner contends that it would be obvious to modify the accent frame to have any desired shape since such a modification would have involved a mere change in the shape of the component and would provide different decorative motives.

14. In response to applicant's argument that "Baldwin does not show a frame flaring away from the planar surface". Examiner asserts that Baldwin in Figure 3 clearly shows the frame 11 having the outer surface 27 flaring away from the planar surface 23. In addition, examiner would like to note that the term "flare" is considered to be "a shape that spreads outward". Thus the claimed limitations are met.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADRIANA FIGUEROA whose telephone number is (571)272-8281. The examiner can normally be reached on M-Th 7:30 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on (571)272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ADRIANA FIGUEROA/
Examiner, Art Unit 3633
07/02/2010

/Brian E. Glessner/
Primary Examiner, Art Unit 3633